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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/643,963	05/07/96	SCHULHOF	N

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B3M1/1014

EXAMINER DAM, T
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ART UNIT 2414	PAPER NUMBER 4
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DATE MAILED: 10/14/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/643,963

Applicant(s)  
SCHULHOF et al.

Examiner  
Tuan Dam

Group Art Unit  
2414



☒ Responsive to communication(s) filed on May 7, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-52 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### DETAILED ACTION

1. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

*The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.*

As set forth in the parent application entitled "Portable Information Storage/Playback Apparatus Having A Data Interface", U.S. Serial No. 08/450,818, filed on 25 May 1995, the specification fails to provide any specifics on the "universal data interface 45". It is not explained whether such device is a commercially available device, or a device that needs to be customized in order to implement the claimed invention. Further, it seems that the universal data interface is one of the key elements in devising the present invention. Thus, without any explanation on such key element, the disclosure is not enabling.

2. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the phrase "universal data interface to receive a data/text data/audio data file as part of an incoming signal, in digitized and compressed format, and to provide automatic data format recognition for the data file" does not appear in the specification, so as the parent application as noted above.

***Claim Rejections - 35 USC § 112***

3. *Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.*

Claims 1-50 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

4. *Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

Referring to claims 1, 10, 18, 27, 35 & 44, recite the limitation "universal data interface....and to provide automatic data format recognition...". It is not clear how these function are achieved.

***Claim Rejections - 35 USC § 102***

5. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

*A person shall be entitled to a patent unless --*

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

6. Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Schulhof et al , 5,557,541(Schulhof).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Referring to claims 1-34, *Schulhof*, Figs. 1-6 & claims 1-6, discloses a portable audio information storage and playback device 40 including a data interface (docking interface device 36 which interface with an incoming signal from cable system 28), a microprocessor (processor 66, Fig. 2) and such transfer rate (col. 8 line 14 to col. 9 line 67 describes as such when the order process is completed, the audio program is received and recorded digitally in a manner that faster than a real time format and, faster than, in retrieved for reproduction in real time format), a diskette recording means (portable storage medium 50 and write 67, Fig. 2), playback means & audio output and conditioning means (mobile docking device 44 and interface 42). The processor of *Schulhof* operates in response to user operation of key pad 48 to select audio program material. *Schulhof* teaches that the subscriber selects a dedicated cable channel that displays a menu for controlling the system which includes an indexed display of material available to the subscriber from the library 18 which contains audio program materials stored in digital format, including a text-to-speech conversion means as col. 6 lines 22-32 states "It is anticipated that one important use of the invention is as a subscription service. For example, a daily newspaper, such as the Wall St. Journal or the New York Times, may be transcribed each morning into an audio version, that is then digitized and delivered to the library 18. In this way...allows a subscriber to listen to the news in a way that the news is not interrupted by commercial breaks and is not truncated to fit into a tight broadcast schedule.", as well as various delivery options and transaction costs (col. 7 lines 36-43).

Further, *Schulhof* discloses different communications environments for implementing the present invention such as satellite based system, broadcast based system, and media on-demand system (Figs. 5-7, col. 6 lines 49-60). It is inherent that different protocol would be implemented as appropriate depending on what kind of communication environment the system is adapted. For example, such a telephone modem would be required for telephone communication link, such a known digital text-to-speech software program would be required for such as a subscription service feature. The program selection may be made from the subscriber's television and/or a standard interactive cable television converter (col. 6 lines 39-48). *Schulhof* also teaches a memory of a PCMCIA type (col. 4 line 67), and a display means (display 79 in Fig. 4).

### ***Claim Rejections - 35 USC § 103***

7. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

8. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as U.S. Patent No. 5,557,541 at the time this invention was made. Accordingly, the patent is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under subsection (e) of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

9. Claims **35-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schulhof et al*, 5,557,541 (*Schulhof*).

Referring to claims 35-43 & 44-52, these are another apparatus versions of the discussed claimed invention above, claims 1-9/10-17/18-26/27-34, thus the rationales provided in the rejection of claims 1-34 are incorporated and applied herein. Although, *Schulhof* does not specifically disclose such limitations as such a data file interrogation means for removing and discarding the E-mail routing information, i.e. routing header. However, note that *Schulhof* teaches that for such as a subscription service (which is anticipated that one important use of the patent, as noted above) wherein digitized text may be transcribed from a daily newspaper, as well as E-mail once such communication links have made which is well within the environment and capabilities of the patent, so that a morning newspaper in audio format can be listening with convenient by the user (of course, it would be much desirable to have or playback with an audio program with only material or information of interest, without audible gaps between paper's columns and/or, audible speech, foot notes such as 'see/continue on page # and column #', etc.) then certainly, for the same desirable purposes, as well as a practical matter for storing or accumulating programs, as a subscription service, for such an E-mail version, it would be appreciated and become apparent to one skilled in the pertinent art to recognized that removing and discarding routing header so that a playback audio version only contains the main message

portion, and since normal message packet format contains an indicator for end-of-routing-information so examining and/or determining as such routing header would become apparent and well within the level of skill of an ordinary skill in the pertinent art and, accordingly, would have been obvious. Thus, such specific claimed subject matter to includes as such "a data file interrogation means" it would have been obvious to one of ordinary skill in the pertinent art to recognized the desirable and/or advantageous purposes, as noted above, of such feature and would have implement the same for such an the audio information storage and playback system.

10. The background art of interest is cited by the examiner. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan Dam whose telephone number is (703) 305-4552. The examiner can normally be reached on Tuesday-Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703) 305-9714.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5356 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

TQD  
10/08/97

*Eric W. Stamber*  
ERIC W. STAMBER  
PATENT EXAMINER  
ART UNIT 2414